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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,399	07/25/2001	Chiaki Matano	211861US3	3527

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EXAMINER

CHOP, ANDREA MARIE

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 04/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. 09/911,399	Applicant(s) Matano
Examiner Andrea Chop	Art Unit 3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on \_\_\_\_\_.

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-15 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-15 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

15)  Notice of References Cited (PTO-892) 18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 19)  Notice of Informal Patent Application (PTO-152)

17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20)  Other: \_\_\_\_\_

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**DETAILED ACTION**

*Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. § 119, which papers have been placed of record in the file.

*Drawings*

2. It should be noted that the drawings have not yet been reviewed by a PTO draftsman. The drawings will be reviewed upon allowance of the application and Applicant will be apprised of their status accordingly.

*Claim Rejections - 35 USC § 112*

3. Claims 2 and 8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As concerns Claims 2 and 8, these claims do not further limit the prior claim, since these claims contain only functional/intended use limitations. Note that the claims cannot be amended

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to positively claim the interaction between the ring and the body, since such would be drawn to nonstatutory subject matter under 35 U.S.C. 101.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over GPI Web Client Printout for

JP 410075809A in view of Slowinski US 5,548,976.

JP '809 shows a ring with stones affixed on opposite sides of the ring, but lacks ditch portions. Slowinski teaches the use of ditch portions to set a stone below the surface of the band. It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the stones to be set in ditch portions in view of Slowinski in order to provide a means of allowing the stones to be cleaned easily and to prevent the stones from being damaged from impacts to the ring surface. In regards to the specific stones claimed, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to use any of the stones claimed, since the examiner takes Official Notice of the use of diamonds, sapphires, rubies,

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and emeralds in jewelry and the selection of any of these known stones to use would be within the level of ordinary skill in the art.

6. Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over GPI Web Client Printout for JP 410075809A in view of Slowinski US 5,548,976 and Kirshbaum US 3,307,374.

JP '809 shows a ring with stones affixed on opposite sides of the ring, but lacks ditch portions and initials. Slowinski teaches the use of ditch portions to set a stone below the surface of the band. It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the stones to be set in ditch portions in view of Slowinski in order to provide a means of allowing the stones to be cleaned easily and to prevent the stones from being damaged from impacts to the ring surface. Kirshbaum teaches the use of indicia on rings. It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the ring to include indicia in view of Kirshbaum in order to provide a more personalized ring. In regards to the specific stones claimed, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to use any of the stones claimed, since the examiner takes Official Notice of the use of diamonds, sapphires, rubies, and emeralds in jewelry and the selection of any of these known stones to use would be within the level of ordinary skill in the art.

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*Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The art cited shows various structures similar to Applicant's.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea Chop whose telephone number is (703) 305-6358. The fax numbers for the Group are (703) 305-3597/8.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2168.

*Andrea Chop*  
ANDREA CHOP  
PATENT EXAMINER  
Art Unit 3628

AMC  
March 22, 2002